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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/431,849	11/02/1999	OIL VER NICKEL	BEIERSDORF-5	9291

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 10/18/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/431,849

Applicant(s)

NICKEL, OILVER

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed July 30, 2002.

Claims 2-9 and 11-12 are pending with claim 11 withdrawn from consideration as drawn to a non-elected invention.

Claim Rejections – 35 USC 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel et al. (US 5,385,783) in view of Sakumoto et al. (US 5,683,806) further in view of Leeuwenburgh (U.S. 5,935,669).

Patel discloses a high temperature resistant masking tape comprising a paper substrate, a release coat on one surface of said paper, and an adhesive on the other surface of said paper (abstract; col. 2, lines 1-5) comprising a maximum heat resistance of 165°C (specification, col. 1, line 23) and a tape comprised of conventional crepe paper (specification, col. 1, lines 59-60). The reference discloses a tape that is rolled up on a core (specification, col. 1, line 42). Patel does not disclose a film. While Patel does not disclose a specific width or thickness for the adhesive tape, he does state that

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the tape can be prepared into predetermined widths and lengths. Patel does not disclose that the masking film is folded or a polyolefin film.

Sakumoto teaches an adhesive tape comprising a heat resistant base film and a protective adhesive layer laminated on at least one surface of said base film (abstract, col. 2, lines 1-3). This protective laminated adhesive layer can be made out of polyolefin, such as polyphenylene (specification, col. 1, line 21). Sakumoto teaches that the protective layer has a thickness of from 1 to 200 μ m (specification, col. 2, line 54-55).

Patel and Sakumoto are analogous art because they are from the same field of endeavor, that is masking tape. At the time of the invention, it is obvious to a person of ordinary skill in the art to combine the protective laminated adhesive layer of Sakumoto with the adhesive layer of Patel in order to provide protection for the adhesive layer of Patel so it would not lose its bonding properties. Neither reference teaches the masking film being folded or the masking film extending beyond said second edge of the masking paper.

Leeuwenburgh teaches a cover sheet folded with extending folds protruding beyond the other folding layers, an adhesive tape being fastened along the longitudinal edge portion (abstract) where the folded material is rolled (column 1, lines 64-65). Although Leeuwenburgh does not explicitly teach his cover sheet is a masking strip, it comprises the same materials and has the same function as applicants claimed masking strip, absent any evidence to the contrary. All the references are analogous art because they are from the same field of adhesive tapes. It would have been obvious to one of ordinary skill in the art to fold the masking strip of Patel leaving extended portions

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because Leeuwenberg teaches this is a conventional practice within the art and the extended portion can be used to adhere the strip to various surfaces.

Response to Arguments

4. Applicant's remarks to 35 USC 103 rejections as being unpatentable over Patel et al. (US 5,385,783) in view of Sakumoto et al. (US 5,683,806) further in view of Leeuwenburgh (U.S. 5,935,669) have been considered but are unpersuasive. Applicant acknowledges the Patel reference does not disclose a film, a specific width or thickness for the adhesive tape, the masking film being folded and a polyolefin film; however, Applicant fails to address why the combined references cannot teach these functions and/or components. Applicant rather focuses on differences not addressed in the office action. Applicant argues the rejection not teach 'a heat-resistant adhesive tape comprising a paper support one side of which is coated with a contact adhesive.' Applicant points to Figure 3 of Patel and column 4, lines 43-46. Applicant argues the 'adhesive contacts the primer' and not the paper support. This is not true because the Patel teaches the adhesive contacting the primer in column 1, lines 46-50, stating, the invention provides a high temperature resistant masking tape comprising a) a paper substrate, b) an impregnant in said paper substrate, c) a release coat on one surface of said paper, and d) an adhesive on the other surface of the paper. Applicant further argues the rejection does not include the contact adhesive is partially covered by masking paper and the remainder of the contact adhesive is covered by a masking film.

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Applicant argues Patel does not teach or suggest the use of a masking paper/masking film on the contact adhesive layer and there is no motivation to add this feature to the invention because the adhesive layer is protected by the release coat as the tape is rolled up. As Patel in view of Sakumoto discloses both a making paper and masking film, one of ordinary skill in the art would be motivated to cover the adhesive layer because, as mentioned before, Patel discloses a high temperature resistant masking tape comprising a) a paper substrate, b) an impregnant in said paper substrate, c) a release coat on one surface of said paper, and d) an adhesive on the other surface of the paper in column 1, lines 46-50, meaning the paper and/or tape does in fact contact the adhesive layer.

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

